

MAR 20 2006

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BANNER &amp; WITCOFF

PTO/SB/17 (12-04v2)

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<b>FEE TRANSMITTAL for FY 2005</b>		Application Number	10/037,297
		Filing Date	December 21, 2001
		First Named Inventor	Tao Wu
		Examiner Name	Emmanuel Coffy
		Art Unit	2157
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Attorney Docket No.	005288.00021
<b>TOTAL AMOUNT OF PAYMENT</b>		<b>(\$)</b> 500.00	

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**FEE CALCULATION**

1. BASIC FILING, SEARCH, AND EXAMINATION FEES							
Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____


2. EXCESS CLAIM FEES		
Fee Description	Small Entity Fee (\$)	Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 30 (including Reissues)	200	100
Multiple dependent claims	360	180
<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>
_____ -20 or HP= _____	x _____	= _____
HP = highest number of total claims paid for, if greater than 20.		
<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>
_____ -3 or HP= _____	x _____	= _____
HP = highest number of independent claims paid for, if greater than 3.		

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If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			
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Non-English Specification, \$130 fee (no small entity discount)	_____
Other (e.g., late filing surcharge): Filing A Brief in Support of an Appeal	\$500.00

<b>SUBMITTED BY</b>			
Signature		Registration No. (Attorney/Agent)	56,197
Name (Print/Type)	Shawn P. Gorman	Telephone	(312) 463-5000
		Date	March 20, 2006

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YOUR REFERENCE NO.:

OUR REFERENCE (C/M) NO.:

10/037,297

005288.00021

RE: U.S. Application Serial No. 10/037,297  
Filed: December 21, 2001  
Entitled: Cache On Demand  
Group Art Unit: 2157  
Confirmation No.: 4505  
Examiner: Emmanuel Coffy  
Attorney Ref. 005288.00021

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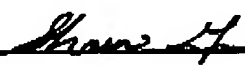
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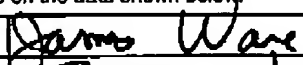
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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/037,297	
	Filing Date	December 21, 2001	
	First Named Inventor	Tao Wu	
	Art Unit	2157	
	Examiner Name	Emmanuel Coffy	
Total Number of Pages in This Submission	30	Attorney Docket Number	005288.00021

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) ____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply/Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Fax Cover Sheet Brief on Appeal
<b>Remarks</b> The Commissioner is hereby authorized to charge any deficiencies in payment or credit any overpayment to our Deposit Account 19-0733.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Banner & Witcoff, LTD.		
Signature			
Printed Name	Shawn P. Gorman		
Date	March 20, 2006	Reg. No.	56,197

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Signature			
Typed or printed name	James Ware	Date	March 20, 2006

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MAR 20 2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**  
(Attorney Docket No. 005288.00021)

In re U.S. Patent Application of	)	
Tao Wu, et al.	)	
	)	Confirmation No. 4505
Application No. 10/037,297	)	
	)	Group Art Unit: 2157
Filed: December 21, 2001	)	
	)	Examiner: Emmanuel Coffy
For: Cache On Demand	)	
	)	

**BRIEF ON APPEAL**

Mail Stop: Appeal Brief-Patents  
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This is an appeal brief in accordance with 37 CFR §1.192 filed in support of Applicant's January 11, 2006 Notice of Appeal. Appeal is taken from the Non-Final Office Action dated February 6, 2006. Please charge any necessary fees in connection with this appeal brief to our Deposit Account No. 19-0733.

03/21/2006 SSESHE1 00000026 190733 10037297

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Appeal Brief dated 03/15/06

Application No. 10/037,297

**I. REAL PARTY IN INTEREST**

The owner of this application, and the real party in interest, is NOKIA, Inc.

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**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals and interferences.

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**III. STATUS OF CLAIMS**

Claims 1 – 23 remain in the application. All of the pending claims are shown in the attached appendix.

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**IV. STATUS OF AMENDMENTS**

There are no amendments subsequent to the final office action dated August 12, 2005, and all prior amendments have been entered.



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**V. SUMMARY OF CLAIMED SUBJECT MATTER**

In making reference herein to various portions of the specification and drawings in order to explain the claimed invention (as required by 37 CFR §41.37(c)(1)(v)), Applicant does not intend to limit the claims. All references to the specification and drawings are illustrative unless otherwise explicitly stated.

The claimed subject matter is directed to improved systems and methods for allowing computer devices to negotiate over the use of a cache memory. (Page 2, Paragraph 5, lines 1-2). Uses of the claimed systems and methods may be advantageous for computing devices in a network, such as the Internet. Indeed, modern Internet websites use objects that have large memory requirements and/or require large bandwidths for transmission to remote computers, thus creating latency delays that often result in users visiting alternative websites to purchase similar goods and services. (Page 1, Paragraph 2, lines 5 - 9).

One prior attempt to alleviate latency delays involves storing content in a cache memory coupled to the access router. The cache memory is configured to store all received content until the memory is full. When the memory is full, the oldest content is deleted. Such systems reduce latency, but fail to optimize the use of cache memories. As a result, the performance of cache memories becomes degraded or designers use larger cache memories than would otherwise be required. (Page 1, Paragraph 3, lines 1 - 6).

By negotiating over the use of a cache computer according to various aspects of the invention, non-requested content may be received at a cache computer for subsequent use. Independent claim 1 is directed to a method of transmitting requests and content at a cache computer, wherein a first computer device and a second computer device are coupled to the cache computer (Page 5, Paragraph 19, lines 5 - 7; Figure 1), and the first computer device

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requests content from the second computer device (Pages 4 – 5, Paragraph 18, lines 6 – 8). Claim 1 includes two elements. The first element is “(a) receiving a cache request from the second computer device” (Page 5, Paragraph 20, lines 5 – 7). An exemplary method of transmitting content from a website to a cache computer is illustrated in Figure 2, where the cache computer receives a cache request for content in step 202. Figure 1 shows an exemplary website 102 being in coupled to a cache computer 112.

The other element in claim 1 is “(b) receiving at the cache computer non-requested content from the second computer device, wherein the non-requested content is content other than content requested by the first computer device (Page 7, Paragraph 24, lines 2 – 3). As shown in steps 220 and 222 of Figure 2, the website selects and transmits the non-requested content to the cache computer. The non-requested content may be chosen based on a variety of different factors, such as predicting the content “the computer device will select next. For example, if the computer device requested content for a particular web page, the website may select object used to create the next web page.” (Pages 7 – 8, Paragraph 24, lines 6 – 10).

Independent claim 22 is directed to a computer-readable medium containing computer executable instructions for causing a cache computer to perform the steps of independent claim 1.

Independent claim 13 is directed to a method of transmitting content from a first computer device to a second computer device, wherein the first computer device and the second computer device are coupled to a cache computer device (Page 4, Paragraph 16, lines 1 – 12; Page 5, Paragraph 19, lines 5 – 7; Figure 1). Claim 13 includes three limitations. The first limitation is “(a) receiving from the cache computer device, a request for content”. (Page 8, Paragraph 26, lines 2 – 3). As shown in Figure 3, the cache computer device may request content from a website (Fig. 3, step 302).

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Another limitation in claim 13 is "(b) transmitting to the cache computer device the requested content". (Page 9, Paragraph 27, line 1). In one embodiment, the requested content may include objects for creating an Internet web page. (Page 9, Paragraph 27, line 2). Another limitation is "(c) transmitting to the cache computer device a request for use of a cache memory". (Page 8, Paragraph 26, lines 6 – 7, Figure 3, step 304; *see also* Page 6, Paragraph 20 for further description of the request which is referred to as a "cache reservation request"). The transmission of the requested content may be performed before or after, and may be independent of the request for use of the cache memory. (Page 9, Paragraph 27, lines 2 – 7).

The last element of claim 13 is "(d) after accepting terms for the use of the cache memory, transmitting to the cache computer device non-requested content, wherein the non-requested content is content other than content requested by the cache computer device". (Page 9, Paragraph 27, lines 7 – 11; Fig. 3, step 316). As discussed above, the non-requested content may be chosen based on a variety of different factors, such as predicting the content "the computer device will select next. For example, if the computer device requested content for a particular web page, the website may select object used to create the next web page." (Pages 7 – 8, Paragraph 24, lines 6 – 10).

Independent claim 23 is directed to an access router including a cache module coupled to a local computer and a website. (Page 4, Paragraph 16, lines 1 – 12; Page 5, Paragraph 19, lines 5 – 7; Figure 1) The cache module is configured to perform at least the two limitations of claim 23. The first limitation is "(a) receiving a cache request from the website". (Page 5, Paragraph 20, lines 5 – 7). The second limitation was "(b) receiving non-requested content from the website, wherein the non-requested is content other than content requested by the local computer". (Page 7, Paragraph 24, lines 2 – 3; Figure 2, steps 220 and 222).

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**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

- 1) Claims 1, 2, 4, and 22 stand rejected under 35 USC §103 as being unpatentable by U.S. Patent No. 6,578,073 ("the '073 patent") to Starnes, et al. in view of Chong, Jr., U.S. Patent No. 6,397,267 ("the '267 patent").
- 2) Claim 3 is rejected under 35 USC §103(a) as being unpatentable over Starnes et al., U.S. Patent No. 6,578,073 in view of Chong, Jr., U.S. Patent No. 6,397,267 in further view of Cieslak et al., U.S. Patent No. 6,832,252 ("the '252 patent").
- 3) Claims 5-9 are rejected under 35 USC §103(a) as being unpatentable over Starnes et al., U.S. Patent No. 6,578,073 in view of Chong, Jr., U.S. Patent No. 6,397,267 in further view of Einarson et al., U.S. Patent No. 6,704,781 ("the '781 patent").
- 4) Claims 10-11 are rejected under 35 USC §103(a) as being unpatentable over Starnes et al., U.S. Patent No. 6,578,073 in view of Chong, Jr., U.S. Patent No. 6,397,267 in further view of Aviani et al., U.S. Patent No. 5,950,205 ("the '205 patent").
- 5) Claim 12 is rejected under 35 USC §103(a) as being unpatentable over Starnes et al., U.S. Patent No. 6,578,073 in view of Chong, Jr., U.S. Patent No. 6,397,267 in further view of Aviani et al., U.S. Patent No. 5,950,250 and in further view of Cieslak et al., U.S. Patent No. 6,832,252.
- 6) Claims 13-20 and 23 are rejected under 35 USC §103(a) as being unpatentable over Einarson et al., U.S. Patent No. 6,704,781 in view of Chong, Jr., U.S. Patent No. 6,397,267 ("the '267 patent").

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- 7) Claim 16 is rejected under 35 USC §103(a) as being unpatentable over Einarson et al., U.S. Patent No. 6,704,781 in view of Chong, Jr., U.S. Patent No. 6,397,267 in further view of Krishnamurthy et al., U.S. Patent No. 6,578,113 ("the '113 patent").
- 8) Claim 21 is rejected under 35 USC §103(a) as being unpatentable over Einarson et al., U.S. Patent No. 6,704,781 in view of Chong, Jr., U.S. Patent No. 6,397,267 in further view of Cieslak et al., U.S. Patent No. 6,832,252.

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**VII. ARGUMENT****A. Neither the '073 Patent Nor the '267 Patent Teach the Receiving of Non-Requested Content at a Cache Computer As Recited in Claims 1 and 22**

As discussed in detail above, Claims 1 and 22 recite the receiving of non-requested content at a cache computer. Moreover, claims 1 and 22 specify that the non-requested content is content other than content requested by the first computer device.

In the Office Action dated February 10, 2005, the Examiner initially alleged that claims 1 and 22 were anticipated by the '267 patent, asserting the step of "receiving at the cache computer non-requested content from the second computer device, wherein the non-requested content is content other than content requested by the first computer device" is somehow found in Col. 7, lines 30 - 33. The rejection was withdrawn after the Applicants demonstrated the '267 patent is merely directed to a method of transferring data between a host computer and a storage device. Indeed, the text cited by the Examiner referred to "a computer system 30 having a different embodiment of the storage controller 26". (See Col. 6, lines 59-60; emphasis added).

In fact, the Applicants requested: "If this rejection is maintained, the Applicants respectfully requests that the Office explicitly indicate which elements in the '267 patent meet the claimed "first computer device", "second computer device" and "cache computer"." (Response filed 05/10/05; page 8). The rejection was withdrawn and no clarification was provided.

In the next Office Action dated August 12, 2005, the Examiner asserted the same step is met by Col. 8, lines 42 - 56 of the '073 patent. The Office Action set forth that "pre-fetch images are actually non-requested data". (Office Action dated 08/12/2005; see, e.g., pgs. 3 and 4). Despite the Applicants' Response filed September 9, 2005 demonstrating the pre-fetch

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images are merely data already associated with a requested HTML document, this rejection was maintained through the Advisory Action. However, due to a docketing error, the exact same Response filed on September 12, 2005 was again considered by the Examiner after issuance of the Advisory Action. Upon a second review of the same Response, the Examiner conceded that Starnes "does not explicitly teach non-requested data". (Office Action dated February 6, 2006; page 3).

The Examiner, however, now returns to the initial allegation that the step is somehow found in Col. 7 of the '267 patent. It appears from the Office Action that the Examiner is again alleging that the claimed "second computer" is met by the host computer 12 or the storage device 16 of the '267 patent (shown in Figure 4A). The cited text and illustrative figure, however, illustrate "a computer system 30 having a different embodiment of the storage controller 26". (Col. 6, lines 59-60) The Applicants again submit that neither the cited text nor remainder of the specification does not teach or otherwise disclose a "second computer" or a "cache computer" as recited in the claims. In fact, the Examiner has yet to specify what elements the '267 patent show a "second computer" or a "cache computer" as requested in the Response dated February 10, 2005 when the reference was initially asserted.

As previously argued, the '267 patent is merely directed towards a single computer system having a storage controller integrated therein. As stated in the '267 patent: "a computer system of the present invention includes a storage controller coupled to the host computer and the storage device." (Col. 3, lines 5 – 7). As recited in the '267 patent, "[t]he purpose of the storage controller is to manage the storage for the host processor". (Col 1, lines 29 – 30). There is no indication the storage controller can be a separate computer (i.e., cache computer), nor is there any indication the storage device can be a second computer. In contrast, the specification of the

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present application states “[c]ache computer device 112, local computer 104 and access router 110 are typically part of an access network, such as a LAN. However, as shown by path 114, cache computer device 112 may be coupled to access router 110 via a wide area network, such as the Internet 108.” (Specification, paragraph 19, lines 5 – 8). In contrast, the Applicants cannot locate the terms “internet”, “network” or “router” anywhere in the ‘267 patent.

Moreover, as discussed in more detail below, several of the references cited by the Examiner in the Office Action (*i.e.*, the ‘781 and ‘252 patents) illustrate that the problems and restrictions faced when transmitting information among computers in a network are vastly different than those when transmitting information from a storage device to a host computer through a storage controller. For example, the ‘781 patent teaches compensation for caching appliances that “can be used to reduce the amount of bandwidth consumed by an ISP by serving some requests from a local cache.” (Col. 1, lines 21-25; emphasis added). This is not a main factor considered when transferring information from a host computer to a coupled storage device, such as that disclosed in the ‘267 patent. Therefore, one skilled in the art at the time of the present invention would not be motivated to transmit non-requested data to a computing device across a network, such as the web.

For at least these reasons, the Applicants respectfully request reversal of the 35 U.S.C. §103 rejection of claims 1, 2, 4 and 22 and request allowance of any dependant claims. The Applicants further request allowance of any claim that is rejected under 35 U.S.C. § 103 utilizing the ‘073 patent or the ‘267 patent.



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**B. Combining the '073 Patent with the '781 Patent is Improper****a. Combining the '073 patent with the '781 patent Does Not Teach, Disclose, or Suggest the Subject Matter of Claims 5 – 9.**

In the Office Action dated February 6, 2006, the Examiner rejected claims 5 – 9 as obvious over the '073 patent in view of the '267 patent and in further view of the '781 patent. (Office Action; page 5). Claim 1, from which claims 5 – 9 depend, recites the receiving of non-requested content at a cache computer, wherein the non-requested content is content other than content requested by the first computer device. As discussed above, this limitation is not taught, disclosed, or suggested in the '073 patent or in the '267 patent.

This limitation is also not taught, disclosed, or suggested by the '781 patent. As set forth in the After Final Response dated September 12, 2005:

The secondary reference, the '781 patent, teaches caching appliances that “can be used to reduce the amount of bandwidth consumed by an ISP by serving some requests from a local cache.” (Col. 1, lines 21-25; emphasis added). Indeed, the caching appliances serve requests from the cache, not unrequested data, as claimed in the present invention.

As set forth in 35 U.S.C. § 112, para. 4: “A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers”. Since the Office Action is silent as to where the '781 patent discloses this limitation, the Applicants respectfully request reversal of this rejection and allowance of any claim rejected under the '781 patent under 35 U.S.C. § 103.

**b. The '781 Patent Teaches Away from the Subject Matter of the Rejected Claims**

As set forth in the September 12, 2005 Response, the '781 patent is directed to compensation for caching services, where the caching systems “reduce the amount of bandwidth consumed” by serving some requests from a local cache. In this regard, the '781 patent teaches away from the subject matter of rejected claims 5 – 9. Indeed, one skilled in the art will readily

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appreciate that the "receiving of non-requested content" increases the amount of bandwidth consumed. For at least this reason the Applicants respectfully request reversal of the rejection and request allowance of claims 5 – 9 and allowance of any other claim rejected under the '781 patent under 35 U.S.C. § 103.

**C. Combining the '073 Patent with the '252 Patent is Improper**

**a. The '252 Patent Teaches Away from the Subject Matter of the Rejected Claims**

As set forth in the Response dated September 12, 2005:

[The] '252 patent can be interpreted as teaching away from receiving non-requested data, as it expressly acknowledges the bandwidth restraint historically associated with transferring files across the web. (See, e.g., Col. 1, lines 38-41, setting forth "Given the increase of traffic on the World Wide Web and the growing bandwidth demands of ever more sophisticated multimedia content, there has been constant pressure to find more efficient ways to service data requests..."). If the requested data is already over congesting the network, one skilled in the art would not transmit more data, never mind unrequested data upon consulting the '252 patent. Therefore, one skilled in the art at the time of the present invention would not be motivated to transmit non-requested data to a computing device across a network, such as the web upon reading the '252 patent.

(Response dated September 12, 2005; page 9). The Applicants respectfully disagree with the Examiner's assertion that the above is a "frivolous interpretation" (Advisory Action dated October 11, 2005), but rather believe the '252 patent further demonstrates the novelty of the rejected claims in that the prior attempts to increase efficiency focused on reducing bandwidth demands, rather than requesting more content (*i.e.* unrequested content). For at least this reason the Applicants respectfully request reversal of the rejection and request allowance of claim 3 and allowance of any claim rejected under the '252 patent under 35 U.S.C. § 103.

**b. Combining the '073 Patent with the '252 Patent Does Not Teach, Disclose, or Suggest the Subject Matter of Claim 3.**

In the Office Action dated February 6, 2006, the Examiner rejected claim 3 as obvious over the '073 patent in view of the '267 patent in further view of '252 patent. Claim 1, from

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which claim 3 depends, recites the receiving of non-requested content at a cache computer, wherein the non-requested content is content other than content requested by the first computer device. As discussed above, this limitation is not taught, disclosed, or suggested in the '073 patent or the '267 patent.

This limitation is also not taught, disclosed, or suggested by the '252 patent. In fact, the Summary of the Invention of the '252 patent expressly states:

Thus, the present invention provides methods and apparatus for facilitating data transmission in a network. A first data request is received at a first intermediate platform, the first data request indicating a source platform and a destination platform. The first data request is redirected by the first intermediate platform to a first cache platform associated with the intermediate platform. Data received from the first cache platform and corresponding to the first data request are transmitted from the first intermediate platform to the source platform, the transmission indicating origination from the destination platform.

Col. 3, lines 1 – 11; emphasis added. As readily seen throughout the Specification of the '252 patent, any data received was previously requested. Merely, showing a 20-byte header added to a data packet does not teach or suggest the limitations of the base claims. Since the Office Action is silent as to where the '781 patent discloses the limitation of receiving non-requested content as recited in the claims, the Applicants respectfully request reversal of this rejection allowance of any claim rejected under the '781 and/or the '252 patents under 35 U.S.C. §103.

**D. Combining the '781 Patent with the '267 Patent is Improper**

**a. There is no Motivation to Combine the '781 Patent with the '267 Patent**

In the Office Action dated February 6, 2006, the Examiner rejects claims 13 – 20 as obvious over the '078 patent in view of the '267 patent. As a person skilled in the art can readily appreciate, at the time of the present invention, transferring data across a network, such as the world wide web ("web") was restrained by a limited supply of bandwidth. Attempts to prevent congestion while providing the requested information focused on reducing the amount of

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information that had to be transferred across the limited amount of bandwidth. The '781 patent teaches compensation for caching appliances that "can be used to reduce the amount of bandwidth consumed by an ISP by serving some requests from a local cache." (Col. 1, lines 21-25; emphasis added). This is not a main factor considered when transferring information from a host computer to a coupled storage device, such as that disclosed in the '267 patent. Therefore, one skilled in the art at the time of the present invention would not be motivated to transmit non-requested data to a computing device across a network, such as the web.

Despite this, the Office Action asserts it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the patents for the following reasons:

- "in anticipation of future read requests." (alleged motivation for claim 13)
- "improve reliability for data storage and retrieval by reducing latency in data transfers" (alleged motivation for claim 14)
- "efficacy would be improved by the process of anticipation of future read requests" (alleged motivation for claim 23).

One skilled in the art would not be motivated to achieve these ends according to the teachings of the rejected claims by consulting an application which set forth methods and systems for "reduce[ing] the amount of bandwidth consumed." Rather it appears the Examiner is using "impermissible hindsight" when determining the obviousness of the rejected claims. For at least these reasons, the Applicants respectfully request reversal of these grounds of rejection.

**b. Neither Patent Teaches the Subject Matter of the Rejected Claims**

Even when utilizing impermissible hindsight to combine the '267 patent with the '781 patent, the subject matter of the rejected claims are not taught or otherwise suggested. Previously, the August 12, 2005 Office Action admitted the '781 patent does not disclose the limitations of "transmitting to the cache computer device non-requested content" (claim 13) and

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"receiving non-requested content from the website" (claim 23), however, stated the limitations are met at Col. 7, lines 27 – 34 of the '267 patent. It now appears that the Examiner is alleging that the claimed "cache computer" is met by the host computer 12 of the '267 patent (shown in Figure 4A). (In an the Office Action dated February 11, 2005, claims 1 and 22 were rejected under the same reference apparently alleging the host computer 12 was the "first computer device" of the rejected claims). As the Applicants have previously set forth, the '267 patent discloses a host computer that controls a host storage controller and a storage device. The cited text and illustrative figure illustrate "a computer system 30 having a different embodiment of the storage controller 26." Col. 6, lines 59-60. In contrast, claim 23 is directed to:

An access router coupled to a local computer and a website, the access router including a cache module configured to perform the steps comprising:

- (a) receiving a cache request from the website; and
- (b) receiving non-requested content from the website, wherein the non-requested is content other than content requested by the local computer.

(Claim 23, emphasis added; see also Claim 14 directed to "A method of transmitting content from a first computer device to a second computer device, wherein the first computer device and the second computer device are coupled to a cache computer device"). The '267 patent does not disclose, teach, or suggest a website or any computer besides the single host computer. In fact, the Office Action admits the '267 patent "does not explicitly disclose receiving non-requested content from the website, wherein the non-requested [content] is content other than content requested by the local computer". Despite this, however, the Examiner insists the limitation is met because "Chong teaches the concept of transferring non-requested content at Col. 7, lines 27 – 34." Office Action dated February 6, 2006, page 13; *see also* page 10 in reference to the rejection of Claim 13.

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Specifically regarding claim 14, the Examiner asserts that the '267 patent shows a switch coupled to the internet wherein the switch acts as a router. (Office Action dated February 6, 2006, page 10). The Applicants, however cannot locate the terms "internet", "network" or "router" anywhere in the '267 patent.

Since the '267 patent does not even disclose or suggest the limitations of the rejected claims, the Applicants respectfully request reversal of the rejection and allowance of the claims.

**E. No Motivation to Combine Was Provided for Claims 15 and 17 – 20**

The Office Actions dated February 6, 2006 and August 12, 2005 are silent in regards to motivation to combine in relation to claims 15 and 17 – 20. In response to the Applicants' request for such a motivation, the Examiner stated: "it is common Office practice not to provide motivation to combine when the claims are rejected by the primary reference". Advisory Action dated October 11, 2005, page 2. According to M.P.E.P. §706.02(j) "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings."

Thus far, no motivation to combine has been provided to the Applicants, therefore, the Applicants submit the initial burden on the Examiner had not been met and the rejection should be reversed. Furthermore, the Applicants are not aware of any policy or regulation in the C.F.R., U.S.C., M.P.E.P, or Official Gazette which supports the Examiner's assertion. If the policy has been adopted, the Applicants respectfully request citation to the policy.

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**CONCLUSION**

The rejections contained in the Action of August 12, 2005 should be reversed for at least the reasons recited above. Reversal of the rejections is requested.

Date: March 20, 2006

Respectfully submitted,



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**CLAIMS APPENDIX**

1. (Previously Presented) A method of transmitting requests and content at a cache computer, wherein a first computer device and a second computer device are coupled to the cache computer and the first computer device requests content from the second computer device; the method comprising the steps of:

(a) receiving a cache request from the second computer device; and

(b) receiving at the cache computer non-requested content from the second computer device, wherein the non-requested content is content other than content requested by the first computer device.

2. (Original) The method of claim 1, further including

(c) transmitting a cache invitation to the second computer device.

3. (Original) The method of claim 2, wherein the cache invitation is located within a header of a request for content.

4. (Original) The method of claim 1, wherein (a) comprises:

(d) receiving a request for cache memory space from the second computer.

5. (Previously Presented) The method of claim 4, wherein the request includes terms that have previously been agreed upon by the cache computer and the second computer device.



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6. (Original) The method of claim 4, wherein the request comprise a fee for use of the cache memory space.

7. (Original) The method of claim 6, wherein the fee is a fee that will be paid by the second computer device.

8. (Original) The method of claim 4, wherein the request further includes a requested amount of cache memory space.

9. (Original) The method of claim 4, wherein the non-requested content comprises objects of a web page.

10. (Original) The method of claim 1, further including:

(c) receiving at the cache computer the identification of non-requested content.

11. (Original) The method of claim 10, wherein the identification of non-requested content comprises memory addresses of non-requested content.

12. (Original) The method of claim 10, in response to (c) further including:

(e) requesting the non-requested content from the second computer

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13. (Original) A method of transmitting content from a first computer device to a second computer device, wherein the first computer device and the second computer device are coupled to a cache computer device, the method comprising the steps of:

- (a) receiving from the cache computer device, a request for content;
- (b) transmitting to the cache computer device the requested content;
- (c) transmitting to the cache computer device a request for use of a cache memory; and
- (d) after accepting terms for the use of the cache memory, transmitting to the cache computer device non-requested content, wherein the non-requested is content other than content requested by the cache computer device.

14. (Original) The method of claim 13, wherein the cache computer device comprises an access router coupled to an access network.

15. (Original) The method of claim 13, wherein the request in (c) comprises a proposed fee for use of the cache memory.

16 (Original) The method of claim 13, further including the steps of:

- (e) determining when the first computer device updates the non-requested content; and
- (f) transmitting updated non-requested content to the second computer device when the first computer device updates the non-requested content.

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17. (Original) The method of claim 13, wherein the request in (c) comprises a request for cache memory space.

18. (Original) The method of claim 13, wherein the request in step (c) comprises a time duration.

19. (Original) The method of claim 13, wherein the request in step (c) comprises a proposed fee.

20. (Original) The method of claim 13, further including the steps of:

- (e) receiving a denial in response to the request for the use of the cache memory;
- (f) receiving proposed terms for use of the cache memory; and
- (g) transmitting to the first computer device an approval of the proposed terms for use of the cache memory.

21. (Original) The method of claim 13, wherein the request (c) is located within a header of the requested content.

22. (Previously Presented) A computer-readable medium containing computer-executable instructions for causing a cache computer coupled to a first computer device and a second computer device to perform the steps comprising:

- (a) receiving a cache request from the second computer device; and

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(b) receiving at the cache computer non-requested content from the second computer device, wherein the non-requested content is content other than content requested by the first computer device.

23. (Original) An access router coupled to a local computer and a website, the access router including a cache module configured to perform the steps comprising:

(a) receiving a cache request from the website; and

(b) receiving non-requested content from the website, wherein the non-requested is content other than content requested by the local computer.

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**VIII. EVIDENCE APPENDIX**

None.

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**IX. RELATED PROCEEDINGS APPENDIX**

None.